

REMARKS

This paper is responsive to an Office Action mailed July 10, 2007. Prior to this response, claims 1, 3-7, 9-11, 13-17, 20, 22-28, 30-38, and 41-42 were pending. After amending claims 1, 3, 5-6, 11, 13, 15-16, 20, 22-23, 26-28, 32, 34, 36, and 41-42, claims 1, 3-7, 9-11, 13-17, 20, 22-28, 30-38, and 41-42 remain pending.

In Section 4 of the Office Action, claims 1-5, 7, 15-17, 20-26 and 28 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Carney et al. ("Carney"; US 2002/0080389) in view of Richter et al. ("Richter"; US 6,678,068) and Carter et al. ("Carter"; US 2002/0080389). The Office Action acknowledges that the combination of Carney and Richter fail to disclose the limitation of sending jobs to a device along with a client network address, but that Carter teaches this limitation, and that it would have been obvious to combine the sending of jobs with client network addresses, with Carney and Richter, because it is desirable to provide an economical, full function local print function in a network computing environment. This rejection is traversed as follows.

Carney discloses a process that monitors print jobs. However, Carney does not disclose any means of filtering or cross-referencing print jobs to the clients sending the jobs

At col. 2, ln. 7-15, Richter discloses a prior art process of a print driver user interface that permits a user to select print options and a

destination printer. Generally, Richter discloses a system that establishes a 2-way link between a client computer and a printing system, where the printing system includes a print server interposed between the client computer and the printers (col. 3, ln. 22-39). The print server is able to provide information to the client such as job status, and when a “jam” occurs (col. 5, ln. 18-30). The Office Action states that Richter discloses filtering the job record to create a filtered history of jobs associated with the client, citing col. 23, ln. 7-15. The cited section states (from claim 1):

a client print server link on at least one of the at least one client computers for receiving and displaying the at least one of the plurality of features from the output printing device through the network connection, for filtering information relevant to the client computer, and for receiving and displaying status of each of the at least one print job sent to the output printing device from the client computer, based upon the filtered information.

The cited section states that the client print server link is for filtering information relevant to the client computer, and for receiving and displaying the status of a print job based upon the filtered information. The above-cited passage does not disclose keeping a job history job history. More explicitly, the passage does not disclose a job history that matches client network addresses to jobs having the same network address. In fact, the cited passage does not even disclose the retention of “filtered information”.

The Office Action states that Carter discloses sending jobs to a device along with a client network address, citing col. 4, ln 54-65. The cited passage states:

During submission of a print job, the client sends the job and printer properties along with a device independent print file and client routing information to the server for transformation of the data into a device dependent data stream, called a print-ready format (PRF).

The server transforms the device independent print file data for the appropriate printer device using the job and printer properties submitted with the job and sends the data back to a small receiver on the client using the client routing information. For example, the client routing information can be an internet IP address.

Carter discloses a print job routing system. In Carter, the client sends a print job to a server along with the network address of the client. The server renders the print job into a format compatible with a printer local to the client. The print server uses the 'network address of the client' to return the rendered print job to the originating client.

The client address in Carter's system is stored at the print server, not the imaging device, as recited in claims 1 and 20. In Carter, the client address is used by the server as a communication routing address. The client address is not sent to a printer with the print job.

The Sorkin reference is mentioned on page 9 of the Office Actions. Sorkin discloses a process where a client device sends a "non-print job" having a header that includes the network address of the sending computer (col. 2, ln. 20-26). An acknowledgement is sent from the printer to the sending computer. The acknowledgement includes the network address of the printer. Through this means computer learns the network address of the printer, and is able to send a certain class of communications to the printer, bypassing the spooler (col. 2, ln. 26-41).

From this analysis it can be seen that Sorkin does not send a client address with a print job. Rather, Sorkin sends the client address in a separate “non-print job” type of message. While Sorkin may disclose a method of determining a *printer* address, he does not disclose a process of filtering job history by client address. Neither does Sorkin disclose a process of determining the address of the sending client, as the printer has no use for the client address that is sent to the printer in the “non-print job”.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, the *KSR International Co. v Teleflex Inc.* decision (82 USPQ2d 1385, 1395-1397, 2007) suggests 7 exemplary rationales to support a conclusion of obviousness, which include:

A) Combining prior art elements according to known methods to yield predictable results;

B) Simple substitution of one known element for another to obtain predictable results;

C) Use of known technique to improve similar devices (methods, or products) in the same way;

D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

E) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on

design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

G) Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

The Office Action states that modifications to Carney would have been obvious to one of ordinary skill in the art in light of Richter and Carter. This rejection appears to be most closely grounded in the G) rationale - Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

With respect to this rationale, MPEP 2143 (G) states that the rejection must articulate the following criteria to resolve the *Graham* factual analysis:

(1) a finding that there was some teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings;

(2) a finding that there was a reasonable expectation of success; and

(3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

With respect to the above-referenced first factual analysis criteria, the Sorkin, Richter, and Carter references has been combined

with Carney based upon the assumption that the combination of references discloses all the limitations recited in Applicant's claims 1, 20, and 41-42. While the combination of Carney and Richter may potentially be cited as suggesting a means for a client to access print-job related information, the combination does not disclose creating a history of jobs filtered by the address of the sending client. Carter does not disclose this limitation either. The Office Action acknowledges that Carney and Richter does not disclose sending jobs to a device with the client network address. As pointed out in detail above, neither Sorkin nor Carter disclose a client that sends a print job to an imaging device along with the client address.

Therefore, even if Carney, Richter, Sorkin, and Carter are combined together, that combination does not explicitly disclose every limitation of amended claims 1, 20, and 41-42. Claims 3-5, 7, 9, 13-17, dependent from claim 1, and claims 22-26, 28, 30-32, 36-37, dependent from claim 20, enjoy the same advantages.

The Office Action states that it would have been obvious to apply the features of Carter together with Carney, Sorkin, and Richter to provide an administrative print server application, and to provide an economical, full function local print function in a network computing environment. However, the claimed invention describes functions that are performed in a client and imaging device, not in a print server. Further, the desire to provide a full function local print function does not suggest that Carney's monitoring function or Richter's print server link be modified in such a manner as to suggest the limitations of filtering a job history record, or the sending of a client address along with the print job

to enable the filtering. There is no suggestion in any of the references that a job history is retained, that a client network address is retained with the print job by the printer, or that the printer extracts the client address from a job and retains it in a persistent manner in some relationship to the job performed.

A *prima facie* analysis of motivation is especially critical in the present circumstances since the rejection is predicated on limitations that are not explicitly disclosed in the prior art references. The claimed invention can only be obvious if an artisan makes substantial modifications to the Carney reference. However, there is nothing in the Richter, Sorkin, and Carter references that suggests such a modification.

Neither does the obviousness rejection provide evidence that such a modification would have been obvious to one with skill in the art based upon what was well known at the time of the invention. “(A)nalysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007). However, if the *prima facie* rejection is supported by what was known by a person of ordinary skill in the art then additional evidence should have been provided. Notable, when the source or motivation is not from the prior art references, “the evidence” of motive will likely consist of an explanation or a well-known principle or problem-solving strategy to be applied”. *DyStar*, 464 F.3d at 1366, 80 USPQ2d at 1649. The Office Action does not supply evidence that it was well known at the time of the invention to filter a job history record, or to send a client

address along with a print job to enable a printer to create a job history correlated to client address.

With respect to the second analysis criteria needed to support the G) obviousness rationale, even if an expert were given the Carney, Richter, Sorkin, and Carter references as a foundation, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention. That is, there can be no reasonable expectation of success if the references, and what was known by artisan at the time of the invention, do not teach all the limitations of the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported since the combination of Carney, Richter, Sorkin, and Carter does not explicitly disclose every limitation of claims 1, 20, and 41-42. Neither has a case been supported that Carney can be modified to supply the missing limitations in view of what was well known by a person of skill at the time of the invention. Therefore, the Applicant requests that the rejection of claims 3-5, 7, 9, 11, 13-17, 20, 22-26, 28, 30-32, 36-37, and 41-42 be removed.

In Section 5 of the Office Action claims 6, 27, 33-35, and 40 have been rejected over Carney, Richter, and Carter, in view of Kullick et al. ("Kullick"; US 5,898,823). The Office Action it is acknowledges that the combination of Carney, Carter, and Richter fails to disclose the limitation of a client memory and downloading the job record from the job repository, but that Kullick discloses these limitations, and that it would

have been obvious to combine references to provide the user with a locally stored copy of the job record. This rejection is traversed as follows.

Kullick does not disclose the limitations of an imaging device making a job record where jobs are matched to client addresses. Kullick does not disclose a client sending a client address with a print job to permit an imaging device to make such a record. Therefore, even if the feature of a client memory is added to Carney/Richter/Carter, the combination still does not disclose the limitations of filtering a job history record, or sending a client address along with the job to enable the filtering. These missing limitations are not suggested by the assertion that it would be desirable for a user to have a locally stored copy of the record, since none of the references suggest even making such a record. Further, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention.

A *prima facie* case of obviousness has not been supported since the combination of Carney, Richter, Carter, and Kullick does not explicitly disclose every limitation of claims 1 and 20. Neither has a case been supported that Carney can be modified to supply the missing limitations in view of what was well known by a person of skill at the time of the invention. Therefore, the Applicant requests that the rejection of claims 6, 27, 33-35, and 40 be removed.

In Section 6 of the Office Action claims 10 and 31 have been rejected over Carney, Richter, and Sorkin, in view of Saruwatari (US 2002/0059361). The Office Action acknowledges that Carney/Richter/Carter fail to disclose a client sending an IP address, but that Saruwatari discloses this feature, and that it would have been

obvious to combine the references because it would have been easier to locate a client in a printing network. This rejection is traversed as follows.

Even if Saruwatari's IP address is combined with Carney/Richter/Carter, the combination does not disclose the limitations of filtering a job history record, or sending a client address along with the job to enable the filtering. These missing limitations are not suggested by the assertion that Saruwatari's IP address would make a client easier to find. Further, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention.

A *prima facie* case of obvious has not been supported since the combination of Carney, Richter, Carter, and Saruwatari does not explicitly disclose every limitation of claims 1 and 20. Neither has a case been supported that Carney can be modified to supply the missing limitations in view of what was well known by a person of skill at the time of the invention. Therefore, the Applicant requests that the rejection of claims 10 and 31 be removed.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

Date: 10/7/2008

/Mali/

Gerald Maliszewski
Registration No. 38,054

Customer Number 55,286
P.O. Box 270829
San Diego, CA 92198-2829
Telephone: (858) 451-9950
Facsimile: (858) 451-9869
gerry@ipatentit.net